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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/004,900 | 11/02/2001 | Harry E. Gruber | 00010.US00 | 8511 |
| 27309 | 7590 | 09/07/2005 | EXAMINER | |
| KINTERA INC. ATTN: LEGAL DEPT. 9605 SCRANTON ROAD, SUITE 240 SAN DIEGO, CA 92121 | | | NGUYEN, TAN D | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3629 | |

DATE MAILED: 09/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/004,900

Applicant(s)

GRUBER ET AL

Examiner

Tan Dean D. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 June 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

The amendment filed 6/10/05 has been entered.

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent thereof, subject to the conditions and requirements of this title.

2. As an initial matter, the United States Constitution under Art. 1, §8, cl. 8 gave Congress the power to "[p]romote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries". In carrying out this power, Congress authorized under 35 U.S.C. §101 a grant of a patent to "[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition or matter, or any new and useful improvement thereof." Therefore, a fundamental premise is that a patent is a statutorily created vehicle for Congress to confer an exclusive right to the inventors for "inventions" that promote the progress of "science and the useful arts". The phrase "technological arts" has been created and used by the courts to offer another view of the term "useful arts". See In re Musgrave, 167 USPQ (BNA) 280 (CCPA 1970). Hence, the first test of whether an invention is eligible for a patent is to determine if the invention is within the "technological arts".

3. Further, despite the express language of §101, several judicially created exceptions have been established to exclude certain subject matter as being patentable

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subject matter covered by §101. These exceptions (3) include (1) "laws of nature", (2) "natural phenomena", and (3) "abstract ideas". See *Diamond v. Diehr*, 450, U.S. 175, 185, 209 USPQ (BNA) 1, 7 (198 1). However, courts have found that even if an invention incorporates abstract ideas, such as mathematical algorithms, the invention may nevertheless be statutory subject matter if the invention as a whole produces a "useful, concrete and tangible result." See *State Street Bank & Trust Co. v. Sirattlre Financial Group, Inc.* 149, F.3d 1368, 1973, 47 USPQZd (BNA) 1596 (Fed. Cir. 1998).

4. Mere idea in the abstract (i.e. abstract idea, law of nature, natural phenomena) that do not apply, involve, use or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e. physical sciences as opposed to social sciences, for example), and therefore are found to be non-statutory subject matter. For a process to pass muster, the recited process must somehow apply, involve, use or advance the technological arts.

5. This "two-prong" test was evident when the Court of Customs and Patent Appeals (CCPA) decided an appeal from the Board of Patent Appeals and Interferences (BPAI). See *In re Toma*, 197 USPQ (BNA) 852 (CCPA 1978). In *Toma*, the court held that the recited mathematical algorithm did not render the claim as a whole non-statutory using the *Freeman-Walter-Abele* test as applied to *Gottschalk v. Benson*, 409 U.S. 63, 175, USPQ (BNA) 673 (1972). Additionally, the court decided separately on the issue of the "technological arts". The court developed a "technological arts" analysis:

6. The "technological" or "useful" arts inquiry must focus on whether the claimed

subject matter is statutory, not on whether the product of the claimed subject matter is statutory, not on whether the prior art which the claimed subject matter purports to replace is statutory, and not on whether the claimed subject matter is presently perceived to be an improvement over the prior art, e.g., but whether it "enhances" the operation of a machine. In re Toma at 857.

7. In Toma, the claimed invention was a computer program for translating a source human language (e.g., Russian) into a target human language (e.g., English). The court found that the claimed computer implemented process was within the "technological art" because the claimed invention was an operation being performed by a computer within a computer.

8. The decision in *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* never addressed this prong of the test. In *State Street Bank & Trust Co.*, the court found that the "mathematical exception" using the Freeman-Walter-Abele test has little, if any, application to determining the presence of statutory subject matter but rather, statutory subject matter should be based on whether the operation produces a "useful, concrete and tangible result". See *State Street Bank & Trust Co. at 1374*. Furthermore, the court found that there was no "business method exception" since the court decisions that purported to create such exceptions were based on novelty or lack of enablement issues and not on statutory grounds. Therefore, the court held that "whether the patent's claims are too broad to be patentable is not to be judged under §101, but rather under §§102, 103 and 112." See *State Street Bank & Trust Co. at 1377*. Both of these analysis goes towards whether the claimed invention is non-

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statutory because of the presence of an abstract idea. Indeed, State Street abolished the Freeman-Walter-Abele test used in *Toma*. However, State Street never addressed the second part of the analysis, i.e., the "technological arts" test established in *Toma* because the invention in State Street (i.e., a computerized system for determining the year-end income, expense, and capital gain or loss for the portfolio) was already determined to be within the technological arts under the *Toma* test. This dichotomy has been recently acknowledged by the Board of Patent Appeals and Interferences (BPAI) in affirming a j101 rejection finding the claimed invention to be non-statutory. See *Ex parte Bowman*, 61 USPQ2d (BNA) 1669 (BPAI 2001).

9. Thus the present basis for a 35 USC 101 inquiry is a 2-prong test:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

10. Claims 29, 21-26, 28, 1-11 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

11. As to the 2nd-prong test, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In the present case, as to claim 26, the claimed invention appears to produce a result "making a donation to the ORG" which is accepted (i.e., useful, concrete and tangible).

12. As to the 1st-prong test, independent claim 29, 21 and its dependent claims, 22-26, 28, independent claim 1 and its dependent claims, 2-11, fail this test. Under this test, for a process claim to pass muster under the "technological arts" prong, the recited process must somehow apply, involve, use, or advance the technological arts. In the

present case, the above claims have no connection to the technological arts. The recited steps of merely "(a) providing a quiz on a website ...; and b) causing a donation to be made ...", does not apply, involve, use, or advance the technological arts in a non-trivial way since all of the recited steps can be performed in the mind of a person, by use of a pencil and paper, then manually and physically presenting to another person. "providing a quiz on a website" is not sufficient to overcome this rejection since it is only a trivial use of technology, such as sending a request by e-mail, while all the other steps as mentioned above may be mental or manual only.

13. Although the recited process produces a useful, concrete, and tangible result, since the claimed invention, as a whole, is not within the technological arts in a non-trivial way as explained above, claims 29, 21-26, 28, 1-11 are deemed to be directed to non-statutory subject matter.

14. To overcome this rejection the Examiner recommends that Applicant amend the claims to better clarify which of the steps are being performed within the technological arts, such as incorporating a computer network or electronic network into some of the steps; for example: "totalizing the answers using a computer network, or calculating the performance using the computer network; and (e) calculating the donation amount using a computer network". The other claims could be similarly amended to include a computer network or a computer, in a significant way, in at least some of the steps.

15. See also (1) In re Schrader, 22 F.3d 290, 30 USPQ2d 1455 (CCPA 1994), (2) In re Alappat, 33 F.3d at 1544, 31 USPQ2d at 1557, (3) In re Waldbaum, 173 USPQ 430

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(CCPA 1972), (4) In re Musgrave, 167 USPQ 280 (CCPA 1970), and (5) In re Johnston, 183 USPQ 172.

Claim Rejections - 35 USC § 103

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

18. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

19. Claims 29, 21-26, 28, 27, 1-11, and 12-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over JEOPARDY Article (November 1997) in view of ENTERTAINMENT Article (May 2000) or INTERLOTTO (Article 1/96).

As for independent method^{1/3} claim 29, JEOPARDY Article teaches a fund-raising method, comprising:

- (a) providing a quiz to a participant on a site, and
- (b) causing a donation to be made by a sponsor to a fundraising organization ("charity" or "worthy causes" which normally raise funds such as Red Cross, Salvation Army or Cancer Society) in response to taking of the quiz by the participant.

JEOPARDY Article fairly teaches the claimed invention except for carrying it out on a web-based or web site. Note that the claim uses the open language "comprising" in the preamble which is open to include other elements or steps.

ENTERTAINMENT Article is cited to teach carrying out the television game show Jeopardy on line (on Internet or on a web site "boxerjam.com", a popular interactive online game web site) {see page 1}. It would have been obvious to modify the game show of JEOPARDY Article by putting it on line as taught by ENTERTAINMENT Article to inherently obtain well known benefits of Internet such as availability, accessibility, cost, speed, etc., as compared to television.

INTERLOTTO Article is cited to teach well known concept of playing game on line (on a website) and making a donation by a sponsor to charity in response to participant playing the game {see text on page 1}. It would have been obvious to modify

the game show of JEOPARDY Article by putting it on line as taught by ENTERTAINMENT Article to inherently obtain well known benefits of Internet such as availability, accessibility, cost, speed, etc., as compared to television.

As for independent method²³ claim 21, which has similar limitations (steps) as in claim 29 above, with additional limitations (a) and (b) in the preamble, these limitations are inherently included in the teachings of JEOPARDY Article /ENTERTAINMENT Article or INTERLOTTO Article. Note that the claim uses the open language "comprising" in the preamble which is open to include other elements or steps.

As for dependent claims 22, 23 (part of 21), which deal with awarding parameters of the player, these are taught in JEOPARDY Article or INTERLOTTO Article.

As for dep. claims 24, 25 (part of 21), which deal with on-line or web communication parameters between parties, i.e. using email or email address, these are well known parameters which are inherently included or would have been obvious to use them in view of the teachings of JEOPARDY Article /ENTERTAINMENT Article or INTERLOTTO Article.

As for dependent claims 26, 28 (part of 21), which deal with awarding parameters and donating parameters, these are taught in JEOPARDY Article ("all selected by insiders") or INTERLOTTO Article "which players select").

As for Independent Product claim 27, which is the computer program product to carryout the method claim 21 above, it's rejected over the computer program product of JEOPARDY Article in view of INTERLOTTO Article or ENTERTAINMENT Article to carry out the method claim 21 as rejected above.

As for independent method^{3/3} claim 1, which has similar limitations (steps) as in claim 29 above, with additional limitations (a) and (b) in the preamble, these limitations are inherently included in the teachings of JEOPARDY Article /ENTERTAINMENT Article or INTERLOTTO Article. Note that the claim uses the open language "comprising" in the preamble which is open to include other elements or steps.

As for dependent claims 2-3 (part of 1), which deal with the types of questions or quiz, it's well known that the Jeopardy quiz show contains a variety of subjects, i.e. history, business, sport, art, geography, politics, etc., and the selection of each subject depends on the contestant's desire or selection. Therefore, as for the selection of questions does not appear to be essential to the scope of the claimed invention and the specific selection of the topics, i.e. related to the organization or sponsor's mission or activities, would have been obvious as mere routine experimentation or if desired to further advertise or increase the awareness about the organization/sponsor.

As for dependent claims 4-5, 8-9 (part of 1), which are similar to dep. claims 24-25 above, they are rejected for the same reasons set forth in dep. claims 24-25 above.

As for dependent claims 6-7 (part of 1), which have the same limitations as in dep. claims 22-23 above, they are rejected for the same reasons set forth in dep. claims 22-23 above.

As for dependent claim 10 (part of 1), which has the same limitations as in dep. claim 28 above, it's rejected for the same reasons set forth in dep. claim 28 above.

As for dependent claim 11 (part of 1), which has the same limitations as in dep. claim 23 above, it's rejected for the same reasons set forth in dep. claim 28 above.

As for Independent System claim 12, which is the web-based interactive system to carry out the web-based interactive method claim 1 above, it's rejected for the same reasons set forth in claim 1 above (merely changing from "step for" to "means for").

As for dep. claims 13-20 (part of 12), which have the same limitations as in dep. claims 2-11 (part of 1) above, they are rejected for the same reasons set forth in dep. claims 2-11 above.

20. Claims 2-7, 13-18 are rejected (2nd time) under 35 U.S.C. 103(a) as being unpatentable over JEOPARDY Article /ENTERTAINMENT Article or INTERLOTTO Article as applied to claims 1 (or 12) above, and further in view of eCOUNTRIES Article (Dec. 2000).

As for dependent claims 2-3 (part of 1), in a similar web-based, interactive method for advertising and increasing awareness of organization through a game/quiz show, eCOUNTRIES Article teaches the idea of quizzing /asking questions the game contestant/participant about the organization business or activities (business models, issues, etc.) to build awareness about the company or promote the company, eCountries or eCountries' core belief or unique business models, which would inherently improve sales {see page 1, 1st full paragraph}. eCOUNTRIES Article indicates that each winner of the "Global Challenge" will receive a reward and the opportunity to win an overall grand prize. It would have been obvious to modify the

method of JEOPARDY Article /ENTERTAINMENT Article or INTERLOTTO Article by asking questions /quiz about the Sponsor's business model or activities or core belief as taught by eCOUNTRIES Article for the motivation cited above, which is to build awareness about the company or promote the company, eCountries or eCountries' core belief or unique business models, which would inherently improve sales.

As for dependent claims 4-5 (part of 1), these limitations are also taught in eCOUNTRIES Article on page 2, see contact fjonathan@eCountries.com or Donal@ecountries.com or nick.lakin@uk.ogilvypr.com.

As for dependent claims 6-7 (part of 1), these limitations are also taught in eCOUNTRIES Article on page 1, last paragraph.

As for dep. claims 13-18 (part of 12), which have the same limitations as in dep. claims 2-7 (part of 1) above, they are rejected for the same reasons set forth in dep. claims 2-7 above.

21. Claims 2-5, 8-9, 13-16, 19-20 are rejected (3rd time) under 35 U.S.C. 103(a) as being unpatentable over JEOPARDY Article /ENTERTAINMENT Article or INTERLOTTO Article as applied to claims 1 (or 12) above, and further in view of SHAHAR.

As for dependent claims 2-3 (part of 1), in a similar web-based, interactive method for advertising and increasing awareness of organization through a game/quiz show, SHAHAR discloses the concept of increasing awareness of company's business / products would eventually increase sales or sales of products {see [0015]}. It would have been obvious to modify the method of JEOPARDY Article /ENTERTAINMENT

Article or INTERLOTTO Article by asking questions /quiz about the Sponsor's business / products as taught by SHAHAR for the motivation cited above, which is to build awareness about the company and improve sales of products.

As for dependent claims 4-5, 8-9 (part of 1), these limitations are also taught in SHAHAR on [0024, 0025].

As for dep. claims 13-16, 19-20 (part of 12), which have the same limitations as in dep. claims 2-5, 8-9 (part of 1) above, they are rejected for the same reasons set forth in dep. claims 2-5, 8-9 above.

Conclusion

22. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Article "Empowerment: . Learning", July 1, 1996, is cited to teach the use of a business game to empower the employees about the company business, having fun while learning about the company business, and awarding the participant for answering the questions correctly. The company is paying about \$1,250 for each manager/employee to play and employee may win \$100.00 for answering questions correctly. The company could have given some of the expense cost to charity to obtain good will for worthy cause and receive tax deductible incomes while promoting the employees to learn about the business which well help the bottom line such as sale, profit, customer service, etc.

No claims are allowed.

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23. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through private PAIR only. For more information about the PAIR system, see <http://pair-direct@uspto.gov>. Should you have any questions on access to the private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).


In receiving an Office Action, it becomes apparent that certain documents are missing, e. g. copies of references, Forms PTO 1449, PTO-892, etc., requests for copies should be directed to Tech Center 3600 Customer Service at (571) 272-3600, or e-mail CustomerService3600@uspto.gov.

Any inquiry concerning the merits of the examination of the application should be directed to Dean Tan Nguyen at telephone number (571) 272-6806. My work schedule is normally Monday through Friday from 6:30 am - 4:00 pm. I am scheduled to be off every other Friday.

Should I be unavailable during my normal working hours, my supervisor John Weiss can be reached at (571) 272-6812.

The main FAX phone numbers for formal communications concerning this application are (571) 273-8300. My personal Fax is (571) 273-6806. Informal communications may be made, following a telephone call to the examiner, by an informal FAX number to be given.

dtn
September 6, 2005


DEANT. NGUYEN
PRIMARY EXAMINER